No. _____

In the Supreme Court of the United States

HARTCO ENGINEERING, INC.,

Petitioner,

v.

WANG'S INTERNATIONAL, INC., PILOT AUTOMOTIVE, INC., PEP BOYS - MANNY, MOE & JACK, INC., AND OVERTON'S, INC.

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

(1) Will this Court allow the Federal Circuit to effectively supplant this Court's *Gorham* rule that:

> [I]f, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

with the Federal Circuit's own contrary rule that "design patent protection is very narrow"[1] and "design patents have almost no scope?"[2] Gorham Mfg. Co. v. White, 81 U.S. 511 at 528, 530 (1871).

(2) Should the verbal claim-construction procedure required in Markman v. Westview Instruments, 517 U.S. 370 (1996), for utility patents also be required for design patents where the sole claim is the "general [visual] appearance and effect"[3] shown in the patent drawings?

(3) Does the Federal Circuit's policy of reserving exclusively to itself the fact finding as to what constitutes substantial sameness in the eye of the ordinary observer violate plaintiff's Seventh Amendment right to trial by jury?

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[1] *Hartco Engineering, Inc. v. Wang's International, Inc.*, 04-1480 et seq. (Fed. Cir. 7/25/05).

[2] *E.g., In Re Mann*, 861 F.2d 1581, 1582 (Fed. Cir. 1988).

[3] *Gorham* at 531.

RULE 14.1(b) STATEMENT

A list of all parties to the proceeding in the Court whose judgment is the subject of this petition is as follows:

Plaintiff-Petitioner: Hartco Engineering, Inc.

Defendants-Respondents: Wang's International, Inc.
Pilot Automotive, Inc.
The Pep Boys - Manny, Moe and Jack
Overton's, Inc.

RULE 29.6 STATEMENT

Petitioner, Hartco Engineering, Inc., is solely owned and operated by Carol and Cary Harwood. It has no parent corporation and no publicly-held company owns any of its stock.

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PETITION FOR WRIT OF CERTIORARI

Petitioner, Hartco Engineering, Inc. ("Hartco"), respectfully petitions for a writ of *certiorari* to review the judgment in this case of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinion of the Court of Appeals (App. B) is reported at 142 Fed.Appx. 455 (Fed.Cir. Jul 25, 2005). The opinions of the District (App. E and F) are reported at 2004 WL 3403371 (E.D. La. 2004) and 2004 WL 3403370 (E.D. La. 2004).

JURISDICTION

The judgment of the Court of Appeals was entered on July 25, 2005, and the Court of Appeals denied respondent's rehearing petition on August 29, 2005.

This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

The District Court was vested with original jurisdiction as to the patent infringement claims under 28 U.S.C. § 1338, 35 U.S.C. § 281.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOKED

The Seventh Amendment of the United States Constitution provides:

> In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

35 U.S.C. § 171 provides:

> Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.
>
> The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

37 C.F.R. § 1.153(a) provides:

> (a) The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

STATEMENT OF THE CASE

A. Importance of the Issue Presented

The Federal Circuit's decision herein conflicts with this Court's decision in *Gorham Mfg. Co. v. White*, *supra*, on an important question of federal patent law. Moreover, the Federal Circuit's decision in this and similar cases violates the Seventh Amendment right of trial by jury in design patent cases.

Design patents have been statutorily protected by United States law since 1842. In 1871, in *Gorham Mfg. Co. v. White*, this Court explained that the patent law protects designs against not only literal copying, but also against colorable imitations, *i.e.*, products which mimic the "general appearance of the [patented] design [but with] minor differences of detail [so that] the two design are substantially the same ... such as to deceive the [ordinary] observer, inducing him to purchase one supposing it to be the other."

Design patents are today extremely important items of intellectual property to tens of thousands of design patent holders.

Federal Circuit decisions culminating in the case at bar have virtually stripped design patents of the protection previously afforded by Congress and by this Court's *Gorham* decision. In effect, current Federal Circuit decisions and policy protect design patents only in the very rare case of literal infringement and allow piracy of design patents provided the copier makes a minor colorable change although that change is unnoticed and of no significance to the ordinary observer. This is absolutely contrary to the *Gorham* rule.